

REMARKS

The application has been amended to place it in condition for allowance at the time of the next Official Action.

The specification is amended to include section heading to address the specification objection noted on page 2 of the Official Action.

Claims 1, 2, 8-11, 13, 16 and 20 are pending in the application.

Claims 1, 8-11, 13 and 20 were rejected under 35 USC 103(a) as unpatentable over OVERES et al. U.S. Publication No. 2002/0156480 in view of KINNETT 6,852,115. That rejection is respectfully traversed.

The Official Action recognizes that OVERES fails to disclose juxtaposed roller bearings. KINNETT is offered for this feature with the Official Action concluding that it would have been obvious to modify the plate of OVERES in order to facilitate the sliding of the implant into place.

However, this position is believed to be clearly untenable for at least the following reasons.

First, the proposed combination of references disregards the claimed invention as a whole.

The Federal Circuit has held that in determining the differences between the prior art and the claims, the question under 35 USC 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole

would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

OVERES uses two parallel support plates that are inserted between opposing portions of the knee and moves the plates apart from each other in order to spread the knee portions for surgical operations.

KINNETT teaches a support 16 that is inserted into a cavity of a bone. The support includes longitudinal roller bearings 20 that are radially movable within slots 36 to expand once inside the bone to anchor the support inside the bone. See column 5, line 65 to column 6, line 8. Thus, contrary to the position set forth in the Official Action, the roller bearings do not facilitate the sliding of the implant into place. Therefore, the motivation offered in the Official Action does not possess a rational underpinning to support the legal conclusion of obviousness.

Moreover, based on the disparate teachings of the references, not only does it appear impossible to combine the references in the manner suggested, but also, there could no motivation for replacing the plate of OVERES with the roller bearings of KINNETT. That is, the roller bearings of KINNETT perform a completely different function in a completely different manner than the plate of OVERES.

In view of the above, it is apparent that when the claimed invention is viewed as a whole, the claimed invention would not have been obvious.

Second, even if one were to consider the proposed combination of references in the first instance, OVERES teaches away from the proposed combination.

Paragraph [0007], lines 4-8 of OVERES discloses the connection of the plate using a laterally receding web that is only on one side of the plate in order to facilitate insertion.

The roller bearings of KINNETT need to be supported on each side that has a roller bearing. See, for example, Figure 4 of KINNETT wherein the roller bearings 20 are supported in opposing slots 36. Such a configuration would not enable the insertion required by OVERES. Thus, the proposed combination of references does not meet the present claims.

Claims 2 and 16 were rejected under 35 USC 103(a) over OVERES in view of KINNETT and further in view of MARTINI 6,558,392. That rejection is respectfully traversed.

MARTINI is only cited with respect to features of the dependent claims. MARTINI does not overcome the shortcomings of the OVERES/KINNETT combination set forth above with respect to claim 1. Since claims 2 and 16 depend from claim 1 and further define the invention, these claims are believed patentable at least for depending from an allowable independent claim.

In addition, MARTINI does not provide any motivation to improve upon a device for the knee as MARTINI is directed to a method of positioning a device in a patient's mouth, which has a completely different structure than the knee.

Moreover, it does not appear that MARTINI discloses that which is recited. The Official Action suggests that Figure 2 of MARTINI shows a hemispherical element 20. A hemisphere is half a sphere or other round object. In contrast, a cylinder has straight sides.

In any event, OVERES teaches away from a concave or dish-shaped plate. Paragraph [0007] discloses that deformation of the parallel (flat) plate is unwanted. Therefore, it would not have been obvious to modify the flat plate of OVERES to a form of a dish as recited in claim 2 or a substantially cylindrical shape as recited in claim 16 as such would deform the plate.

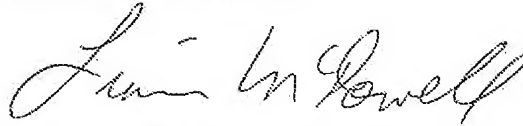
In view of the present amendment and the foregoing remarks, therefore, it is believed that this application has been placed in condition for allowance, and reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional  
fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

A handwritten signature in cursive script, appearing to read "Liam McDowell", is written over a horizontal line.

Liam McDowell, Reg. No. 44,231  
209 Madison Street  
Suite 500  
Alexandria, VA 223134  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

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